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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,543	05/26/2000	Beatrice Gaugler	LUD 5353.5 (10016355)	7364

24972 7590 06/27/2003  
FULBRIGHT & JAWORSKI, LLP  
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NEW YORK, NY 10103-3198

EXAMINER
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HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/27/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/579,543

Applicant(s)

GAUGLER ET AL.

Examiner

Alana M. Harris, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/26/02; 2/6/03; 4/17/03.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-58, 60, 61 and 63-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38-58, 60, 61 and 63-65 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 21, 22.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. As indicated in the attached interview summary Applicants requested a written Office Action as set forth below.

### ***Election/Restrictions***

2. The election/restrictions requirement set forth in Paper number 12, mailed March 18, 2002 has been vacated. Applicants attested in Paper number 18/Amendment G received November 26, 2002 that SEQ ID NOS: 13-15 do not constitute different inventions. SEQ ID NO: 13 and SEQ ID NO: 15 are named MAGE-4 and SEQ ID NO: 14 is termed MAGE-41. Applicants set forth that there is a total of 2 nucleotide differences with the open reading frame shared between SEQ ID NO: 13 and 14 and constitutes one amino acid difference with the protein and does not impact the tumor rejection antigen (TRA) known as MAGE-4. Upon reconsideration SEQ ID NO: 14 is rejoined with SEQ ID NO: 13 and 15.

3. Claims 38-58, 60, 61 and 63-66 are pending.

Claims 39, 41, 61, 64 and 66 have been amended.

Claims 59 and 62 have been canceled.

Claims 38-58, 60, 61 and 63-66 are examined on the merits.

***Withdrawn Objection***

***Claim Objections***

4. The objection of claims 38-41, 43-45, 58, 60, 61, 64 and 66 because of the claims referenced non-elected sequence, SEQ ID NO: 14 is withdrawn in view that SEQ ID NO: 14 has been rejoined with SEQ ID NO: 13 and 15.

***Sequence Compliance***

5. The sequence disclosures on page 35, lines 15, 16, 32 and 34; page 36, line 24 are now compliant with the requirements of 37 C.F.R. §§ 1.821-1.825 due to Amendment G received November 26, 2002.

6. The amendment to the claims filed on April 17, 2002 does not comply with the requirements of 37 CFR 1.121(c) because claim 66 has been amended improperly. Original claim 66, line 1 cited “ (i) nucleotides 625-1575 of SEQ ID NO: 13: ii” and line 2 cited “(ii) nucleotides 625-1575 of SEQ ID NO: 14; or”.

These lines now read “(i) nucleotides 625-1578 of SEQ ID NO: 13: [iii]” and “(ii) nucleotides 625-1578 of SEQ ID NO: 14; or”, respectively.

The changes in nucleic acid residues have not been denoted with an underline or brackets.

Amendments to the claims filed after March 1, 2001 must comply with 37 CFR 1.121(c) which states:

**(c) Claims.**

**(1) Amendment by rewriting, directions to cancel or add:** Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting

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of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

(i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

(ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.

(2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.

7. A supplemental declaration was submitted with Paper number 18 reflecting the proper application number U.S. 07/764,365 (filed September 23, 1991), now abandoned. And an accompanying amendment to the specification cites proper continuity data in the first line of the specification listing the said application number, however it is not listed that this file is now abandoned.

#### ***Oath/Declaration***

8. The oath or declaration is no longer defective. As noted above Applicants supplied a new declaration in compliance with 37 CFR 1.67(a) identifying the instant application by the proper application number and filing date is required.

9. The new declaration lists three inventors instead of four inventors as listed in the originally filed declaration. Applicants remark in a letter received April 17, 2003 within Paper number 20/ Amendment I that in parent application 08/037,230 filed March 26,

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1993 that inventor Beatrice Gaugler was deleted as a co-inventor. The letter further submits that the petition was filed to delete Gaugler as a co-inventor and it is believed that this should address all issues. The petition filed under 37 C.F.R. 1.48(b) is a copy of the original petition filed September 19, 1995. This petition is DISMISSED and the required processing fee under 37 CFR 1.17 has not been charged because the submitted petition does not reference the instant application, U.S. application number 09/579,543, filed May 26, 2000 and its claimed invention. It is noted that the petition addresses U.S. Serial number 08/037, 230 and not the instant application. Applicants are requested to submit a petition under 37 C.F.R. 1.48(b) reflective of the instant application and the deleted co-inventor no longer claims the instant invention.

10. Claims 38-58, 60, 61 and 63-66 are free of the art.

### ***Conclusion***

11. This application is in condition for allowance except for the following formal matters noted in the preceding paragraphs.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (703) 306-5880. The examiner can normally be reached on 6:30 am to 4:00 pm, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4315 for regular communications and (703) 308-4315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

**ALANA HARRIS**  
**PATENT EXAMINER**



Alana M. Harris, Ph.D.  
June 26, 2003